



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,561	10/28/2003	Michael J. Picciallo	P22,425-G USA	9169

7590 01/29/2008
Synnestvedt & Lechner LLP
2600 Aramark Tower
1101 Market Street
Philadelphia, PA 19107-2950

EXAMINER

SHAH, AMEE A

ART UNIT	PAPER NUMBER
----------	--------------

3625

MAIL DATE	DELIVERY MODE
-----------	---------------

01/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/695,561	Applicant(s) PICCIALLO, MICHAEL J.	
	Examiner AMEE A. SHAH	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,11,13,14 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) 22-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,2,4,11,13,14 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-4, 11, 13, 14 and 18-24 are pending in this action.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 10, 2008, has been entered.

Election/Restrictions

Newly submitted claims 22-24 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 22-24 are related to claims 1, 2, 4, 11, 13, 14 and 18-21 as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination of claims 1, 2, 4, 11, 13, 14 and 18-21 has separate utility such as issuing a magnetic card to a third party for access to the funds. See MPEP § 806.05(d). Furthermore, applicant envisions different uses for the methods as indicated in the preambles, i.e. the preamble of claim 1 is directed to a method for transferring funds to third party dependents whereas the preamble for claim 22 is directed to a banking method. Since applicant has received an action on the merits for the originally presented invention, this invention has been

constructively elected by original presentation for prosecution on the merits. Accordingly, claims 22-24 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 08/585,173 (the '173 application), from which this applicant claims benefit as a continuation-in-part, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. In particular, as discussed in the office action mailed November 6, 2006, the '173 application does not disclose storing information on fund transfers and corresponding payment amounts not supplying that information, periodically or automatically, to the fund depositor via e-mail, as recited in the old claim 3 and now

Art Unit: 3625

incorporated into claim 1. Therefore, the priority benefit of the claims extends to June 16, 1997, the filing date of application number 08/876,929.

Examiner Note

Examiner cites particular pages, columns, paragraphs and/or line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 11, 13, 14, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oncken et al., US 4,725,719 (hereafter referred to as “Oncken”) in view of Hilt et al., US 5,465,206 (hereafter referred to as “Hilt”).

Referring to claim 1. Oncken teaches a method for transferring funds to third party dependents (see, e.g., Abstract), comprising creating an account for magnetic card access by a third party financially dependent upon a fund depositor, from which funds may be transferred at the request of said third party as a cash withdrawal or payment for goods or services purchased by said third party and transferring funds to said account and issuing a magnetic card to said third party for access to said funds (Fig. 3, col. 4, lines 11-27, col. 6, lines 53-61, and col. 8, lines 3-7 – note that the fund depositor, i.e. a user such as an employer, can transfer funds to the third party, i.e. an acceptor such as an employee who is financially dependent on the employer, through a magnetic card which can be used similar to a credit card to make purchases). Oncken also teaches storing information on fund transferees and corresponding payment amounts for said account (col. 7, lines 45-54); and automatically providing to said fund depositor an accounting of how said third party spent said funds (col. 7, lines 55-65).

While Oncken teaches automatically providing a monthly statement, i.e. an accounting, to the fund depositor, it does not specifically teach that the statement being provided via e-mail. Hilt, in the same field of endeavor and/or pertaining to the same issue, teaches an electronic bill pay system wherein information is supplied via e-mail (col. 22, lines 41-45, “a message could be interchangeably embodied in a postal mail paper form, an e-mail message, a telephone voice response session, etc.” – note that a message includes information regarding transactions).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to apply the step of providing information via e-mail, as taught by Hilt, to improve the commerce method of Oncken of providing an accounting by paper statements, for

Art Unit: 3625

the predictable result of reducing paper and increasing efficiency, as suggested by Hilt (col. 6, lines 19-21 and col. 20, lines 22-25).

Referring to claim 2. Oncken in view of Hilt teaches the method of claim 1 wherein said transferring step is performed periodically and automatically (Oncken, col. 6, line 62 through col. 7, line 9, and col. 7, lines 65-68 – note that the account is automatically replenished when it reaches a certain value).

Referring to claim 4. Oncken in view of Hilt further teaches the method of claim 1 wherein said funds are supplied to said account through a credit card network (Oncken, Fig. 4 and col. 6, line 63 through col. 7, line 15 and Nakano, Fig. 1, col. 3, line 51 through col. 4, line 7 and col. 8, lines 1-6).

Referring to claims 11 and 20. Oncken in view of Hilt further teaches the method of claim 1 wherein said e-mail accounting is performed periodically/monthly (Oncken, col. 7, lines 59-65 shows that statements are sent monthly and Hilt shows that statements can be sent by e-mail instead of paper).

Referring to claim 13. Oncken in view of Hilt further teaches the method of claim 2 wherein said funds are transferred weekly or monthly (Oncken, col. 7, lines 65-68 and col. 8, lines 3-7).

Referring to claim 14. Oncken in view of Hilt teaches the method of claim 1 with a financially dependent third party of an employee (Oncken, abstract), but does not specifically teach wherein the financially dependent third party is a son or daughter of said fund depositor. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the creating, transferring, issuing, storing or providing steps recited. The creating of an account for a financially dependent third party to access, the transferring of funds to the account, the issuance of a card to the third party, and the storing and providing of information accounting how the third party spent the funds would all be performed in the same manner regardless of whether the third party was an employee or a child. Thus, the non-functional descriptive material will not distinguish the claimed invention from the prior art Wilmott et al. in terms of patentability. *See In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowrey*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to create an account, transfer funds, issue a card, and store and provide information regardless of the specific types of third party dependent, because such information does not functionally relate to the creating, transferring, issuing, storing and providing steps and does not patentably distinguish the claimed invention.

Referring to claim 18. Oncken in view of Hilt further teaches the method of claim 1 wherein said magnetic card is a debit card (Oncken, col. 2, lines 39-50 and col. 3, lines 18-29 – note that the invented method in Oncken discloses an improved method of which a debit card is prior art and one of the cards upon which the invention is an improvement).

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oncken in view of Hilt as applied to claim 1 above, and further in view of Joao et al., US 5,878,337 (hereafter referred to as “Joao”).

Referring to claim 19. Oncken in view of Hilt teaches the method of claim 11, but does not specifically teach the e-mail accounting being performed daily. Joao, in the same field of endeavor and/or pertaining to the same issue, teaches a method for providing account information whereby the account holder can receive information such as transactions records from a server computer on an automatic and periodic basis of daily, weekly, bi-weekly, monthly or any time interval (col. 40, lines 13-54).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to apply the step of providing e-mail accounting information on a daily basis, as taught by Joao, to improve the commerce method of Oncken/Hilt of providing e-mail accounting information for the predictable result of allowing the user to more quickly know if accounts are being used in a fraudulent or unauthorized manner, as suggested by Joao (col. 5, lines 20-26).

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oncken in view of Hilt, as applied to claim 1 above, and further in view of Matsumoto et al., US 6,345,263 (hereafter referred to as “Matsumoto”).

Referring to claim 21. Oncken in view of Hilt teaches the method of claim 1, as discussed supra, including restricting the third party to specific services and/or products

Art Unit: 3625

(Oncken, col. 4, lines 19-27), but does not specifically teach prohibiting spending any amount of funds using the card on alcohol or tobacco. Matsumoto, in the same field of endeavor and/or pertaining to the same issue, teaches an electronic purse system and method having an IC card for storing electronic money information and information for giving transaction conditions and restrictions (col. 1, lines 59-63), including limiting transactions to prohibit any amount of funds to be spent on at least one class of goods or services, particularly alcohol or tobacco (col. 2, lines 6-39 – note that the prohibition on any amount of funds is the using of the age stored to prevent selling of alcoholic drink or cigarettes).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to apply the step of prohibiting spending any amount of funds using the card on alcohol or tobacco, as taught by Matsumoto, to improve the commerce method of Oncken/Hilt of restricting the funds to certain products/services for the predictable result of allowing for “appropriate use of electronic money automatically taking care of restrictions and conditions due to... age,” and “automatically prevent selling to a minor,” thereby providing a control mechanism to ensure money is spent properly and within the condition set forth by a parent or other fund depositor, as suggested in Matsumoto et al. (col. 1, lines 47-58).

Response to Arguments

Applicant's arguments filed January 10, 2008, have been fully considered but they are not persuasive.

In response to applicant's arguments that Hilt does not teach that payment of the bills can be transmitted by e-mail (Remarks, page 6), it is noted that these features upon which applicant

Art Unit: 3625

relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 1 recites providing information of an accounting of funds spent by e-mail. In the event applicant is arguing that Hilt does not show this, application is attacking the references individually, and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Oncken teaches providing the fund depositor a paper statement accounting for how the funds were spent. Hilt teaches that statements sent by paper can also be sent by e-mail. Thus, the combination of Oncken and Hilt teaches providing by e-mail an accounting of how the funds were spent.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMEE A. SHAH whose telephone number is (571)272-8116. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS

January 23, 2008

/Yogesh C Garg/

Primary Examiner, Art Unit 3625